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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/082,957	02/26/2002	Jeffrey H. Nycz	DEP610	5011

27777 7590 03/24/2004  
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EXAMINER

RAMANA, ANURADHA

ART UNIT PAPER NUMBER

3732

DATE MAILED: 03/24/2004

13

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/082,957

Applicant(s)

NYCZ ET AL.

Examiner

Anu Ramana

Art Unit

3732

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 12 February 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 21-40 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 21-40 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 12 February 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_.

## DETAILED ACTION

### *Specification*

The disclosure is objected to because of the following informalities. In the paragraph on page 13, at line 24, the concave inner periphery should be "74" instead of "72" to be consistent with Applicants' disclosure.

Appropriate correction is required.

### *Claim Rejections - 35 USC § 102*

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 21-23, 25-26, 28, 30, 32-33 and 35-38 are rejected under 35 U.S.C. 102(b) as being anticipated by Williamson et al. (US 5,925,077).

Regarding claims 21-23, 25-26, 28, 30, 32-33 and 35-38, Williamson et al. disclose an acetabular prosthesis or cup 10 having a convex surface 22 and a concave surface 20 with portions, each portion 86 being defined by a planar first surface spaced inwardly from the convex surface 22 and a planar surface spaced inwardly from the concave surface 20 (col. 1, lines 7-12, col. 4, lines 10-37, col. 5, lines 43-67 and col. 6, lines 1-12, Figures 3, 10 and 14I).

The method steps of claim 36 are inherently performed during normal use of the prosthesis 10 of Williamson et al. for the purpose of replacement of the acetabulum or hip socket due to bone disease or severe fracture (col. 2, lines 23-37).

### *Claim Rejections - 35 USC § 103*

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person

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having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 21-40 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jones (US 5,370,702).

Regarding claims 21-40, Jones discloses an implant or prosthesis or cup 10 having a convex surface 20 and a concave surface 18. Recesses or "portions" 14 are provided spaced from the convex and concave surfaces; each recess having sidewalls 21, 22a with a removable portion 32, 32a about 0.005 to 0.5 inches thick; the removable portion 32, 32a having a first surface spaced inwardly from the convex surface 20 and a second surface spaced inwardly from the concave surface 18 with grooves 24 extending inwardly from the second surface to the first surface. Jones further discloses that punching may be applied to remove portion 32, 32a to form a hole in cup 10; the hole being used to fasten cup 10 by a bone screw or other fastener (col. 1, lines 8-24; col. 2, lines 14-38 and line 68; col. 3, lines 1-3, lines 13-23 and lines 37-49 and lines 57-64; col. 4, lines 8-47; Figures 1 and 5).

Jones discloses the claimed invention except that the first and second surfaces of the removable portion are "substantially planar." It would have been an obvious matter of design choice to one skilled in the art at the time the invention was made to the removable portion with a "substantially planar surface", since applicant has not disclosed that a "substantially planar surface" solves any stated problem or is anything more than one of numerous shapes or configurations a person ordinary skill in the art would find obvious for the purpose of providing a removable portion in an acetabular cup. *In re Dailey and Eilers*, 149 USPQ 47 (1966).

Regarding claims 23, 30 and 38, Jones discloses that recesses 14, 14a can have any shape depending on the configuration of the fastener that is used (col. 3, lines 44-49).

Accordingly it would have been obvious to one of ordinary skill in the art at the time the invention was made to have provided cylindrical walls to the recesses 14, 14a, in order to place a cylindrical fastener.

Regarding claims 25 and 32, Jones discloses that acetabular cups typically include a liner into which the femoral head fits (col. 1, lines 13-23). It is well known that a femoral head is supported by and operably connected to a stem.

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Accordingly it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide a stem, a femoral head operably connected thereto and a liner positioned between the acetabular cup and the femoral head for replacement of the hip socket.

The method steps of claim 36 are performed during normal use of the prosthesis or cup 10 of Jones for the purpose of replacement of the acetabulum or hip socket due to bone disease or severe fracture (col. 1, lines 13-15).

Claims 24 and 31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Williamson et al. in view of Jones (US 5,370,702).

Williamson et al. do not disclose that ledge 86 has a thickness of 0.10 inches or less.

Jones teaches a removable portion having a thickness of 0.005 to 0.5 inches for ease of removal by applying a pulling or bending force (col. 3, lines 50-64).

Accordingly it would have been obvious to one of ordinary skill in the art at the time the invention was made to have provided the a ledge 86 in the Williamson et al. prosthesis, as taught by Jones, for ease of removal of ledge 86.

#### *Conclusion*

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anu Ramana whose telephone number is (703) 306-4035. The examiner can normally be reached Monday through Friday between 8:00 am to 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kevin Shaver can be reached at (703) 308-2582. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

AR *Anu Ramana*  
March 22, 2004

*Eduardo C. Robert*  
**EDUARDO C. ROBERT**  
**PRIMARY EXAMINER**